

REMARKS

Applicant has amended claims 1, 2, 3, 6, 12, 14, 15, 17, 18, and 21. Claims 4, 5, and 16 have been cancelled. Claim 23 has been added. Claims 1-3, 6-15, and 17-23 remain pending in the application. Claims 1, 11, 12, and 21 are independent.

Claims 1 and 21 has been amended to clearly define the subject matter. In particular, claim 1 now recites, in part,

a mating structure for releasably retaining the peripheral device such that a charging contact extending from the peripheral device is in direct electrical contact with the mobile device retained in the sleeve

Claim 21 now recites, in part,

a charging contact for providing a charge to the battery when placed in direct electrical contact with a charging port of a the mobile device so as to permit the mobile device to charge the battery in the peripheral device.

Claims 2 and 12 have been amended to address clerical errors. Amendments to other claims are clearly identified in the Listing of Claims.

Claim 23 has been added to define the cooperation between the holster mating structure, charging port of the mobile device, a peripheral device mating structure, and the charging contact of the peripheral device to releasably retain the peripheral device. Support for new claim 23 exists in paragraph [0041] of the original specification and in Figs. 4a and 5a.

No new subject matter has been added by virtue of these amendments.

Applicant thanks the Examiner for her consideration of the response dated October 17, 2006.

Claim rejection under 35 U.S.C. § 102(a)

The Examiner has stated on Page 3 of the Office Action that claims 1 to 9 and 11 to 22 are rejected under 35 USC 102(a) as being anticipated by German patent document DE 10134830A1 to Christal. However, on page 2 of the Action, the Examiner has stated, "Applicant's arguments, see pages, filed October 17th, 2006, with respect to the rejection(s) of claim(s) 1-9 and 11-20 under 102(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn." Furthermore, in light of the Examiner's remarks

on pages 2 and 3 of the Action, Applicant believes that the objection under 35 USC 102(a) in item 5 of the Action relates only to claims 21 and 22.

In response, Applicant has amended claim 21 to recite, "so as to permit the mobile device to charge the battery in the peripheral device" to more clearly define the claimed subject matter in line with the other independent claims. Applicant submits that the arguments presented in the response dated October 17, 2006 in support of patentability of claims 1 to 9 and 11 to 20 apply to currently amended claim 21 and to claim 22. The Examiner has found the arguments persuasive to withdraw her objections under 35 USC 102(a) and, therefore, the Applicant requests that the objection to claims 21 and 22 be withdrawn as well.

Claim rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1 to 9 and 11 to 20 as being obvious over Christal and in further view of KR 2002041098A to Kim. Although the Examiner has not rejected claims 21 and 22 under 35 USC 103(a), Applicant has, for completeness, included these claims in the discussions herein.

For the Examiner to establish a prima facie case of obviousness, three criteria must be considered: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all of the claim limitations (MPEP §§ 706.02(j)). For the reasons that follow, Applicant respectfully submits that the Examiner has failed to demonstrate a prima facie case of obviousness.

Applicant reiterates the arguments submitted in the response dated October 17, 2006. In particular, Christal discloses a holder for holding a mobile telephone and a headset used with the mobile telephone. A first embodiment of the holder is shown in Fig. 1A of Christal, at reference numeral 4. A second embodiment is shown in Fig. 2B, at reference numeral 5. Each embodiment of the holder includes an electrical coupler for electrically coupling electrical inputs of the mobile telephone to electrical inputs of the headset. In the first embodiment, the electrical coupler is shown in Fig. 1D at reference numeral 1, and in the second embodiment, the electrical coupler is shown in Fig. 2C, at reference numeral 19. The electrical coupler (1, 19) acts as the interconnect between the electrical inputs of the mobile telephone and the headset and enables recharging of the mobile telephone and of the headset by a single

external battery charger. A battery charger plug (16) connectable to the electrical coupler (1) is shown in Fig. 1D.

Independent claims 1 and 11, each to a holster, recite, in part, "*the peripheral device is in direct electrical contact with the mobile device*". Independent claim 12, to a system, recites, in part, "*the charging port and charging contact are in direct electrical contact*." Independent claim 21, to a peripheral device, recites, in part, "*a charging contact for providing a charge to the battery when placed in direct electrical contact with a charging port of the mobile device*."

Independent claims 1 and 11 recite, in part, "*a mating structure for releasably retaining the peripheral device*". Thus, mating structure of the claimed invention releasably retains the peripheral device such that the peripheral device and the mobile device are in direct electrical contact. The mating structure is not, per se, an "electrical interconnect".

Christal, on the other hand, teaches a separate electrical coupler (1.19) to interconnect the electrical inputs of the mobile telephone and the headset, i.e., there is an indirect electrical connection between the mobile telephone and the headset. Nowhere does Christal teach or suggest direct electrical contact between the charging contact of the peripheral device and the charging port of the mobile device as claimed.

The Examiner has stated that "*Christal also discloses when charging, the headset is in direct electrical contact with the mobile device (paragraph 31, 33)*." Applicant respectfully submits that this is an indirect electrical contact, which is enabled through the separate electrical coupler (1.19) and not by a direct electrical contact between the charging contact of the peripheral device and the charging port of the mobile device as claimed. An advantage of the holster, as claimed, is that the holster can accommodate any size peripheral as long as it is compatible with the charging port of the mobile device. Moreover, different types of peripheral devices (for example, Bluetooth headset or a GPS receiver) can be charged using the claimed invention.

Kim teaches a connector (30) to connect the cellular phone battery (20) to the cordless headset battery (40) as shown in Fig. 2. Kim further discloses that the connector (30) is a cable having a jack. Kim does not teach or disclose a direct electrical contact between the charging contact of the peripheral device and the mobile device as claimed.

Christal and Kim neither individually nor collectively, teach nor suggest, direct electrical contact between the charging contact of the peripheral device and the charging port of the mobile device, thus, they do not teach or suggest all of the claim limitations of independent claims 1, 11, 12, and 21. It follows that merely incorporating the charging of a

battery in the peripheral device from a mobile device disclosed by Kim in the holster of Christal would not have led, in an obvious manner, to the claimed invention.

Furthermore, the mating structure of the holster, as claimed in amended claim 2, allows for the peripheral device to mate with the holster through the peripheral device's mating structure. Christal does not disclose such an arrangement, but teaches a holder with separate compartments for retaining the mobile device and the headset (as in Fig. 1a) or a holder with "hooks" for retaining the mobile device and the headset (as in Fig. 2b). Additionally, mating structure of the holster is provided so that a peripheral device will be held on the holster in such a manner as to allow the peripheral device access to the charging port of the mobile device. This is not the case with the holster taught by Christal. Christal teaches separate electrical interconnects to provide indirect electrical contact between the mobile device and the headset. Thus, the mating structure as claimed is inherently different from the electrical coupler (1,19) of Christal.

Moreover, in the holster of amended claims 3 and 15, the charging port of the peripheral device is in direct physical contact with the charging contact of the mobile device. Nowhere does Christal teach or suggest a direct physical contact between the charging contact of the peripheral device and the charging port of the mobile device. On the other contrary, Christal teaches the use of an electrical interconnect to establish an indirect electrical contact between the mobile device and the headset.

Applicant submits that there is no suggestion or motivation in Christal to have a direct electrical contact between the charging contact of the peripheral device and the charging port of the mobile device. Therefore, there would be no motivation to combine Christal with any of the other references cited. Furthermore, even if there were motivation to combine Christal with any of the other references cited, which the Applicant expressly denies, Applicant submits that Christal fails to teach or suggest all of the claim limitations of the present application. Applicant, therefore, submits that Christal fails, alone or in combination with any of the other cited references, to teach or reasonably suggest the limitations of the claims of the present application.

For the Patent Office to combine references in an obviousness analysis, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references, and second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994,999 (Fed. Cir. 1999). While the range of sources

for the motivation is broad, the range of available sources does not diminish the requirement for actual evidence. *Id.*

In order to prevent hindsight analysis, there must be some motivation or suggestion to combine specific prior art in such a way as to arrive to the combination disclosed in the patent at issue. See, e.g., *Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc.*, 231 F.3d 1339, 1343 (Fed. Cir. 2000): "*the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test of obviousness.*", and *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d at 1371-1372 (Fed. Cir. 2000), "*Combining prior art references without evidence or a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.*"

In view of the failure of any of the cited references to teach or reasonably suggest direct electrical contact between the charging contact of the peripheral device and the mobile device, Applicant respectfully submits that the Examiner can only combine the references with the benefit of hindsight analysis, which is forbidden. Consequently, and in view of the arguments made above with respect Christal's failure to teach or reasonably suggest the limitations of the claims of the present application, each claim rejection by the Examiner based on the Christal reference is unfounded.

Accordingly, it is respectfully submitted that the above-mentioned rejections fail to establish a prima facie case of obviousness, by failing to provide and support an adequate motivation to combine the cited references to support the rejection, and by failing to teach or reasonably suggest all of the limitations of claims 1 to 9 and 11 to 20. Therefore, Applicant respectfully requests that the Examiner withdraw her rejections of claims 1 to 9 and 11 to 20 under 35 U.S.C. § 103(a).

Since claim 10 directly depends from and includes the limitations of independent claim 1, Applicant respectfully requests that the Examiner's rejection of claim 10 under 35 U.S.C. §103(a) also be withdrawn.

The Applicant submits that the application is now in condition for allowance, and favorable action to that end is respectfully requested.

We believe no fee is required. However, if a fee is due, the Commissioner is hereby authorized to charge any additional fees, and credit any over payments to Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP.

Respectfully submitted,

LOWLES, Robert, J.

By: /Curtis B. Behmann/
Curtis B. Behmann
Reg. No. 52,523
Borden Ladner Gervais LLP
World Exchange Plaza
100 Queen Street, Suite 1100
Ottawa, ON K1P 1J9
CANADA
Tel: (613) 787-3596
Fax: (613) 787-3558
E-mail: cbehmann@blgcanada.com

CBB/MC/ats